

REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1, 2, 4-7, 9-12, and 14-30 are pending. No new matter has been added.

Rejection of the claims

In the Office Action, independent claims 1, 6, 11, 19, 20, 24, 25, 29 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,356,922 (“Schilit”).

Claim 1 recites:

1. A method performed by a computer system, comprising:
 - storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
 - at a first location within the version, detecting a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
 - in response to the detected reference, embedding a hyperlink within the detected reference; and
 - while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable by a user to cause an operation associated with the second location.

Claim 6 recites:

6. A system, comprising:
 - a computing device for:
 - storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
 - at a first location within the version, detecting a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
 - in response to the detected reference, embedding a hyperlink within the detected reference; and
 - while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable by a user to cause an operation associated with the second location.

Claim 11 recites:

11. A computer program product, comprising:
a computer program processable by a computer system for causing the computer system to:
store a version of a paper, the version being displayable on a display device as a
likeness of the paper;
at a first location within the version, detect a reference to a second location,
wherein the detected reference is at least one of the following, other than a
computer network address: an alphanumeric character; a symbol; a term;
and a phrase;
in response to the detected reference, embed a hyperlink within the detected
reference; and
while the first location is displayed on the display device, highlight the first
location to indicate the hyperlink as being selectable by a user to cause an
operation associated with the second location; and
apparatus from which the computer program is accessible by the computer system.

Claim 19 recites:

19. A method performed by a computer system, comprising:
storing a version of a paper, the version being displayable on a display device as a
likeness of the paper;
at a first location within the version, detecting a reference to a second location,
wherein the detected reference is at least one of the following, other than a computer
network address: an alphanumeric character; a symbol; a term; and a phrase;
in response to the detected reference, embedding a hyperlink within the detected
reference, wherein the second location is a file external to the paper, and wherein the file
includes audio signal information; and
while the first location is displayed on the display device, highlighting the first
location to indicate the hyperlink as being selectable by a user to cause an operation
associated with the second location, wherein the operation includes outputting audio
signals in response to the audio signal information and a selection of the first location by
the user.

Claim 20 recites:

20. A method performed by a computer system, comprising:
storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
at a first location within the version, detecting a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
in response to the detected reference, embedding a hyperlink within the detected reference, wherein the second location is a script; and
while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable by a user to cause an operation associated with the second location, wherein the operation includes executing the script in response to a selection of the first location by the user.

Claim 24 recites:

24. A system, comprising:
a computing device for:
storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
at a first location within the version, detecting a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
in response to the detected reference, embedding a hyperlink within the detected reference, wherein the second location is a file external to the paper, and wherein the file includes audio signal information; and
while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable by a user to cause an operation associated with the second location, wherein the operation includes outputting audio signals in response to the audio signal information and a selection of the first location by the user.

Claim 25 recites:

25. A system, comprising:
a computing device for:
storing a version of a paper, the version being displayable on a display
device as a likeness of the paper;
at a first location within the version, detecting a reference to a second
location, wherein the detected reference is at least one of the
following, other than a computer network address: an alphanumeric
character; a symbol; a term; and a phrase;
in response to the detected reference, embedding a hyperlink within the
detected reference, wherein the second location is a script; and
while the first location is displayed on the display device, highlighting the
first location to indicate the hyperlink as being selectable by a user
to cause an operation associated with the second location, wherein
the operation includes executing the script in response to a selection
of the first location by the user.

Claim 29 recites:

29. A computer program product, comprising:
a computer program processable by a computer system for causing the computer system to:
store a version of a paper, the version being displayable on a display device as a
likeness of the paper;
at a first location within the version, detect a reference to a second location,
wherein the detected reference is at least one of the following, other than a
computer network address: an alphanumeric character; a symbol; a term;
and a phrase;
in response to the detected reference, embed a hyperlink within the detected
reference, wherein the second location is a file external to the paper, and
wherein the file includes audio signal information; and
while the first location is displayed on the display device, highlight the first
location to indicate the hyperlink as being selectable by a user to cause an
operation associated with the second location, wherein the operation
includes outputting audio signals in response to the audio signal information
and a selection of the first location by the user; and
apparatus from which the computer program is accessible by the computer system.

Claim 30 recites:

30. A computer program product, comprising:
a computer program processable by a computer system for causing the computer system to:
store a version of a paper, the version being displayable on a display device as a
likeness of the paper;
at a first location within the version, detect a reference to a second location,
wherein the detected reference is at least one of the following, other than a
computer network address: an alphanumeric character; a symbol; a term;
and a phrase;
in response to the detected reference, embed a hyperlink within the detected
reference, wherein the second location is a script; and
while the first location is displayed on the display device, highlight the first
location to indicate the hyperlink as being selectable by a user to cause an
operation associated with the second location, wherein the operation
includes executing the script in response to a selection of the first location
by the user; and
apparatus from which the computer program is accessible by the computer system.

MPEP § 2142 states, "...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness..." Further, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

Moreover, MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

In relation to independent claim 1, Schilit is defective in establishing a prima facie conclusion of obviousness. For example, as between Schilit and Applicant's specification, only Applicant's specification teaches the combination of elements in claim 1. In fact, Schilit teaches away from such combination.

For example, in applying Schilit to claim 1, the Office Action states that Schilit detects an

annotation. However, contrary to claim 1, Schilit teaches (at col. 6, lines 1-4), “If the link corresponds to a target portion that is related to the context of a particular annotation then the *link is displayed in a margin* adjacent to the annotation as a *margin representation 34 as shown in FIG. 2*” (emphasis added). As shown in Fig. 2, the margin representation 34 is *not* embedded within the annotation. Instead, the margin representation 34 is merely displayed in the *margin*, where *no* alphanumeric character, *no* symbol, *no* term, and *no* phrase was previously displayed.

By comparison, claim 1 requires: (a) at a first location within the version, *detecting a reference* to a second location, wherein the *detected reference is at least one of the following*, other than a computer network address: *an alphanumeric character; a symbol; a term; and a phrase*; and (b) in response to the detected reference, *embedding a hyperlink within the detected reference*.

Therefore, Schilit (by teaching that its *link is displayed as a margin representation 34*, in a *margin* adjacent to the annotation, so that the margin representation 34 is *not* embedded within the annotation, but instead is merely displayed in the *margin*, where *no* alphanumeric character, *no* symbol, *no* term, and *no* phrase was previously displayed) teaches 180° away from claim 1. Consequently, in relation to claim 1, Schilit is defective in establishing a prima facie case of obviousness.

In relation to claims 6, 11, 19, 20, 24, 25, 29 and 30, Schilit is likewise defective in establishing a prima facie case of obviousness. Accordingly, in view of the reasons stated herein, and for other reasons clearly apparent, the PTO has not met its burden of factually supporting a prima facie conclusion of obviousness in this case, and Applicant has no obligation to submit evidence of nonobviousness.

Thus, a rejection of claims 1, 6, 11, 19, 20, 24, 25, 29 and 30 is not supported.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 6, 11, 19, 20, 24, 25, 29 and 30.

Dependent claims 2, 4, 5 and 16-18 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 7, 9, 10 and 21-23 depend from and further limit claim 6 and therefore are allowable.

Dependent claims 12, 14, 15 and 26-28 depend from and further limit claim 11 and therefore are allowable.

An early formal notice of allowance of claims 1, 2, 4-7, 9-12, and 14-30 is requested.

To the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.

Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

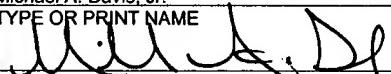
Respectfully submitted,



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I hereby certify that this paper is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
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